

Appln No. 09/693,705  
Amdt. Dated July 22, 2004  
Response to Office action of May 11, 2004

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### REMARKS/ARGUMENTS

#### ***Specification***

The specification has been amended by copying material into the present specification from the co-pending U.S. Application No. 09/575,146 filed 23 May 2000 (now allowed) (docket no. NPP018US), and from co-pending U.S. Application No. 09/575,195 filed on 23 May 2000 (pending) (docket no. NPA002US), which applications are both incorporated by reference into the present application.

#### ***Claims***

Claims 6 and 8-10 were pending in the application and the Examiner rejected claims 6 and 8-10. By this amendment claim 6 has been amended. Therefore claims 6 and 8-10 remain pending in the application.

#### *Claim Rejections – 35 USC §112*

Claims 6 and 8-10 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The rejection is respectfully traversed.

Regarding claims 6 and 8-10 the Examiner stated that the phrase “the printer being adapted to print the map and the coded data substantially simultaneously” is not in the specification. However, claim 53 of the co-pending U.S. Application No. 09/575,146, incorporated by reference into the present application, claims: “A printer according to claim 50, wherein the printer is configured to print the second coded data and additional information substantially simultaneously onto the second surface.” Application No. 09/575,146 further includes the identical paragraph (at page 10, beginning at line 2) describing graphic data printed using visible ink, and coded data printed as a collection of tags using invisible ink, that is included in the present specification and amended by the present amendment. Therefore the present specification has been amended to include the statement that “The graphic data 2 and the coded data 3 are printed substantially simultaneously.”

Further, co-pending U.S. Application no. 09/575,195 filed on 23 May 2000, incorporated by reference into the present application, states on page 27, lines 13-14: “This printer simultaneously prints cyan, magenta, yellow, black, and infrared inks as well as paper conditioner and ink fixative.” Thus that statement has been copied into the present specification in the paragraph beginning on page 10 at line 23, so as to provide better support in the present specification for simultaneous printing of visible graphic data and invisible coded data.

Therefore the Applicants assert that claim 6 now finds proper support in the specification. Further, claim 6 has been amended to clarify that it is the visible graphic data of the map that is printed substantially simultaneously with the coded data.

#### *Claim Rejections – 35 USC §103*

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Claims 6 and 8-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Conroy et al. (US Patent No. 5,686,705) in view of Dymetman et al. (Intelligent Paper; in Electronic Publishing, Artistic Imaging, and Digital Typography) and further in view of Dymetman (WO 99/50787). The rejection is respectfully traversed.

The Examiner acknowledged that Conroy et al. fail to disclose a map surface where a geographic area and coded data are printed substantially simultaneously. Further, the Examiner did not suggest that either reference of Dymetman discloses or fairly suggests printing a map and associated coded data substantially simultaneously.

The Applicants assert that none of the prior art references cited by the Examiner fairly suggest substantially simultaneous printing as defined in the presently amended claims. Further, substantially simultaneous printing represents a significant and non obvious technical improvement over the references cited by the Examiner.

Dymetman et al. (Intelligent Paper) teaches paper that is pre-printed in bulk form by an authorized producer with a coded layer of ink. The paper is then delivered to publishers who print a layer of conventional, visible ink: *"These sheets are produced by publishers, who buy apparently blank sheets of Intelligent Paper from an authorized producer. The publishers can mark them with conventional visible inks in any way they choose."* (Page 394, lines 1 to 3.) The blank sheets include coded data in the form of cells, where each cell includes a page-id and localization information that uniquely defines the position of the cell within the page. (Dymetman, WO 99/50787, page 9, line 30 to page 10, line 1.) Dymetman then further teaches the use of a special pointer (502) to capture data from the cells and feed it to a computer (peripheral 4). (Dymetman, WO 99/50787, page 5, lines 7-18.)

However, Dymetman does not disclose how the page-ids on the pre-printed sheets are associated with a corresponding digital page in the computer network. Some form of manual association process is clearly needed. Otherwise, when the pointer of Dymetman reads a particular page-id, the computer will be unable to associate the page-id with a unique digital page.

On the other hand, according to the present invention no such manual association of each hard copy page-id and corresponding digital page is needed. The substantially simultaneous printing process—by the same computer system—as defined in the present claim 6 enables such association to occur automatically when each hard copy is printed.

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*Conclusion*

The specification has been amended to provide better support for the present claims by copying subject matter from two co-pending applications that are incorporated by reference into the present application. Further, claim 6 has been amended to clarify the substantially simultaneous printing feature of the printer element, which feature is not disclosed or suggested in any of the prior art cited by the Examiner. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

Applicant:

  
SIMON ROBERT WALMSLEY

  
PAUL LAPSTUN

  
JACQUELINE ANNE LAPSTUN

  
KIA SILVERBROOK

C/o: Silverbrook Research Pty Ltd  
393 Darling Street  
Balmain NSW 2041, Australia

Email: [kia.silverbrook@silverbrookresearch.com](mailto:kia.silverbrook@silverbrookresearch.com)  
Telephone: +612 9818 6633  
Facsimile: +61 2 9555 7762